

REMARKS

Applicants thank Examiner Gollamudi for conducting the kind and courteous discussion with Applicants' representative, Daniel R. Evans, on May 30, 2006. The content of the discussion is reflected in the amendments to the claims and the following comments.

The rejection of Claims 1-5, 16-17, 19-20, and 22-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is respectfully traversed.

Applicants believe that the limitation recited in Claim 1, which reads "50 to 99 % by weight of a solvent" is adequately supported in the original disclosure.

Applicants also believe that limitation recited in Claims 32-33, which reads " wherein the at least one oil agent is present in an amount of about 5% by weight and the solvent is present in an amount of about 95% by weight" is adequately supported in the original disclosure.

With respect to the "50 to 99 %" limitation, the Examiner's attention is directed to the present Specification text at page 3, lines 20-22, which reads as follows:

The hair treatment composition preferably comprises 0.5 to 50% by weight, particularly 1 to 25% by weight, of the oil agent and 3 to 99% by weight, particularly 5 to 50% by weight, of the solvent both based on the total composition.

Applicants note that the range "3 to 99% by weight" range is disclosed for the amount of solvent and that the "50 to 99% by weight" range is a sub-range of the "3 to 99% by weight" range. Applicants also direct the Examiner's attention to the present Specification at page 9, which shows that hair-treatment compositions identified as Examples 1-11 all have a solvent content that is 95% by weight. Accordingly, Applicants note that not only is the "50 to 99%

by weight" range supported by inference, but Applicants' disclosed embodiments fall within this range.

It would appear that the Office has taken the position that ranges must be explicitly disclosed. However, Applicants believe that range in question is readily supported by the original disclosure. In this regard, the Examiner's attention is directed to the Office's guidelines at MPEP 2163.02, which reads in part

The " test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))."

In *Ralston Purina Co. v. Far-Mar-Co.*, the Federal Circuit addressed an issue that is akin to the outstanding rejection. *Ralston Purina Co. v. Far-Mar-Co.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). For convenience, Applicants provide the Examiner with a copy of the *Ralston Court's* decision. An issue considered by the *Ralston Court* is whether or not a sub-range is supported by the original disclosure, even though an endpoint of the sub-range is not explicitly disclosed. In short, the *Ralston Court* concluded that it is permissible to do so and handily rejected the " argument that ranges found in the applicant's claim language must correspond exactly to ranges disclosed in the [original disclosure]." *Ralston* at 1575. In particular, the *Ralston Court* found that the claim limitations "into the range of 212° - 310°F" is supported based on an original disclosure that reads "[mixture] must be subjected to heat"; wherein Example 1 of the original disclosure sets forth a range of 212 ° -380 °F. See *Ralston* at 1576. See also *Ralston I* at *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 586 F. Supp. 1176, 1205 (D. Kan. 1984). In fact the *Ralston Court* gave implicit support to the trial court's statement that the claim limitation shown in point (5) above "involves [nothing] more than claiming a portion of that which had been earlier described." See *Ralston I* at 1205.

Like Ralston, Applicants disclose a range that reads "3 to 99% by weight." By claiming a sub-range ("50 to 99% by weight") of this originally disclosed range "involves [nothing] more than claiming a portion of that which had been earlier described." Moreover, Applicants note that the "50% by weight" end-point is not derived from the ether; rather, it is disclosed in the same passage as the range that reads "3 to 99% by weight." Couple this information with the fact that Applicants disclose embodiments that fall within the range "50 to 99% by weight" provides a clear indication that "the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" (see MPEP 2163.02).

With respect to the recitation of "about" in Claims 32-33, Applicants believe that, like the sub-range discussed above, the term "about" is adequately supported in the original disclosure. In this regard, the Examiner's attention is directed to the U.S. Court of Customs and Patent Appeals decision of *In re Eickmeyer*. *In re Eickmeyer*, 602 F.2d 974; 202 U.S.P.Q. 655 (CCPA 1979). Applicants have enclosed a copy of the *In re Eickmeyer* decision for the Examiner's consideration. The application in question is 05/124,413, which issued as U.S. 4,271,132 (US '132) on June 2, 1981, a copy of which is enclosed herewith.

Implicit to the decision rendered *In re Eickmeyer* is whether or not the claim limitation "of at least about 56°C," (see US '132 at col. 12, line 21) is supported by a disclosure that reads "the reaction kinetics of CO₂ absorption were measured with various solutions under identical conditions of atmospheric pressure and temperatures of 56°C. and 80°C. according to the tables which follow" (see US '132 at col. 4, lines 4-8). The CCPA said yes, and once again re-emphasized a recurring theme that in order to "satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that the [applicant] was in possession of the subject matter claimed." *Eickmeyer* at 981. See also MPEP 2163.02.

Applicants believe that the limitation of Claims 32-33 that reads " wherein the at least one oil agent is present in an amount of about 5% by weight and the solvent is present in an amount of about 95% by weight" is adequately supported by the originally filed specification. In view of the foregoing, it is clear that a federal court would conclude the same. Accordingly, Applicants kindly request that the Examiner withdraw the rejection based on 35 U.S.C. § 112, first paragraph.

The rejection of Claims 1-3, 20, 23, and 28-29 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Etheredge (US 5,308,609).

The rejections of any one of Claims 1-5, 16-17, 19-20, and 22-33 under 35 U.S.C. § 103(a) over the combination of any one of the following disclosure: US '609, US 4,279,262 (US '262), US 4,517,175 (US '175), and US 4,296,763 (US '763) are respectfully traversed.

Applicants note that none of the combined references, alone or in combination with one another, disclose or fairly suggest that hair conditions methods recited in Claims 1, 3, and 30. In particular, Applicants note that none of the references disclose or suggest a hair condition method that applies the recited at least one oil agent and solvent as presently claimed.

US '609 discloses hair formulations that contain an oily agent (sebacic acid, eicosane, and/or oleic acid) and a solvent (isopropanol or ethanol). But US '609 does not disclose the application methods as presently claimed. None of the secondary references rectify the deficiency of US '609.

Applicants kindly request that the Examiner acknowledge the same and withdraw these rejections.

The rejection of Claims 1-5, 17, 20, 23, 28-29, 31-32 under 35 U.S.C. § 103(a) over the combined disclosure of JP 64-066107 (JP '107), GB 824,353 (GB '353), and US 4,296,763 (US '763) is respectfully traversed.

JP '107 discloses a liquid and oil cosmetic that contains triethyl citrate, a liquid fatty acid ester having branched chains, ethanol and water. GB '353 discloses a hair oil that contains some selected oils, rum, and some minor components. US '763 discloses a hair conditioner that contains oils, waxes, etc. However, Applicants believe that the combination of JP '107, GB '353, and US '763 fail to disclose or fairly suggest the methods as presently claimed.

Applicants kindly request that the Examiner acknowledge the same and withdraw this rejection.

The rejection of Claims 1, 16-17, 19-20, 22-24, 28, and 30 under 35 U.S.C. § 103(a) over the combination of US 5,342,611 and US 4,402,936 should remain withdrawn because it is believed that the amendment filed January 20, 2006 does not introduce new matter.

In view of the amendments to the claims and the preceding remarks, Applicants believe that the present application is now in a condition for allowance. An early and favorable indication of the same is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Registration No. 36,379

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)